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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/782,611	02/19/2004	Joseph Rake	02280.002870	6314
5514	7590	03/08/2006	EXAMINER	
FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			BUI, LUAN KIM	
			ART UNIT	PAPER NUMBER
			3728	
DATE MAILED: 03/08/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/782,611

Applicant(s)

RAKE ET AL.

Examiner

Luan K. Bui

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 2/19 & 7/15/04.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 2, 5, 7, 9, 11, 13, 14, 15 and 18-20 are rejected under 35 U.S.C. 102(b) as being anticipated by James (2,806,313). James discloses a decorative gift article (10) comprising a gift package decoration (12, 14, 16) and a container (28, 32). The container including a container portion/first portion (28) and a cap/closure/second portion (32) defines an interior volume and inherently capable of holding at least one gift item. The container having a first configuration to secure the at least one item within the container and a second configuration to provide access to the at least one item within the interior volume when the cap is removed from the container portion. James further discloses the gift package decoration comprises a ribbon in the form of a bow and the container is removably attached to the gift package decoration by a pin (20).

As to claim 5, the container (28, 32) is a separate element attached to the gift package decoration by the pin (20).

As to claim 9, James further an adhesive material located on a portion of at least one of the gift package decoration and the container to permit adhering of the article to another surface such as a package (22) (column 2, lines 15-17)>

As to claims 13 and 15, the container of James has a generally domed shape (column 1, line 31).

As to

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As to claim 18, the gift package decoration of James is considered equivalent to one of the symbolic as claimed.

3. Claims 1, 2, 5, 7, 11, 14 and 18-20 are rejected under 35 U.S.C. 102(b) as being anticipated by McCathey (6,422,388). McCathey discloses a decorative gift article (10) comprising a gift package decoration (66) and a container (12, 14). The container including a container portion/first portion (12) and a lid/closure/second portion (14) defines an interior volume and inherently capable of holding at least one gift item. The container having a first configuration to secure the at least one item within the container and a second configuration to provide access to the at least one item within the interior volume when the lid is removed from the container portion. McCathey further discloses the gift package decoration comprises a ribbon in the form of a bow (66) and the container is removably attached to the gift package decoration by a staple member (68).

As to claim 5, the container (14, 14) is a separate element attached to the gift package decoration by the staple member (68).

As to claim 18, the gift package decoration of McCathey is considered equivalent to one of the symbolic as claimed.

4. Claims 1, 2, 5, 7, 11, 12, 14 and 18-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Fleming (5,497,876). Fleming discloses a decorative gift article (2) comprising a gift package decoration (68) and a container (Figures 2A-2C). The container including a container portion/first portion and a lid/closure/second portion defines an interior volume and

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inherently capable of holding at least one gift item. The container having a first configuration to secure the at least one item within the container and a second configuration to provide access to the at least one item within the interior volume when the lid is removed from the container portion. Fleming further discloses the gift package decoration comprises a ribbon in the form of a bow (68) and the container is removably attached to the gift package decoration by a elongate extension (70).

As to claim 5, the container is a separate element attached to the gift package decoration by the elongated extension (70).

As to claim 12, Fleming further discloses at least one tag with writing/legend attached to the container (Figure 2B).

As to claim 18, the gift package decoration of Fleming is considered equivalent to one of the symbolic as claimed.

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 3, 4, 6 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over James (2,806,313). James discloses the decorative gift article (10) as above having all the limitations of the claims including the container (28) formed from glass or plastic/molded

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material. However, James fails to show the gift package decoration and the container being a single piece. It would have been obvious to one having ordinary skill in the art at the time the invention was made in view of James to construct the decorative gift article so the gift package decoration and the container formed from a single piece since it has been held that forming in one piece an article which has formerly been formed in two pieces and put together involves only routine skill in the art. *Howard v. Detroit Stove Works*, 150 U.S. 164 (1893).

The container of James is in the form of a spherical which is considered equivalent to an oblate spheroid.

7. Claims 10 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over James (2,806,313) in view of The Official Notice. James discloses the decorative gift article (10) as above having all the limitations of the claims except for the adhesive comprises a peel-away adhesive strip and the second portion comprises at least one tab. The Official Notice is take of the old and conventional practice of providing an adhesive with a peel-away adhesive strip to allow a user to peel-away the strip prior of attaching the adhesive and The Official Notice is take of the old and conventional practice of providing a container with a cap having at least one tab to facilitate removing the cap from the container. It would have been obvious to one having ordinary skill in the art in view of The Official Notice to modify the adhesive and the cap of James so the adhesive comprises a peel-away adhesive strip to allow a user to peel-away the strip prior of attaching the adhesive and the second portion comprises at least one tab to facilitate removing the second portion from the first portion.

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8. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over James (2,806,313) in view of Goto et al. (5,379,911; hereinafter Goto'911). James discloses the decorative gift article (10) as above having all the limitations of the claims except for a portion of the second portion being configured to fit within a portion of the interior. Goto'911 shows a container comprising a first portion (1) defined an interior volume and a portion (6) of a second portion (2) configured to fit within a portion of the interior volume to secure items within the interior volume. It would have been obvious to one having ordinary skill in the art in view of Goto'911 to modify the second portion of James so a portion of the second portion is configured to fit within a portion of the interior instead of exterior of James for better securing the second portion to the first portion.

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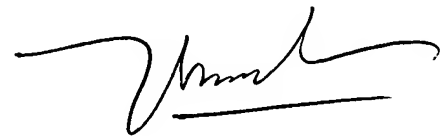
***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Luan K. Bui whose telephone number is 571-272-4552. The examiner can normally be reached on 8:30-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 571-272-4562. **The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300 for Formal papers and After Final communications.**

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

lkb  
March 3, 2006



Luan K. Bui  
Primary Examiner  
Art Unit 3728